

REMARKS***Status of the Application***

In the Office Action dated February 1, 2000, claims 6-8, 10, 11, 16, and 19 were allowed, claims 2, 17, and 20 were rejected, and claims 13-15 and 18 were rejected. In the present Amendment, claim 20 has been cancelled and claims 13-15 and 18 have been amended. Thus, claims 2, 6-8, 10, 11, and 13-19 are pending. The amendments to claims 13-15 and 18 are supported in the application and, thus, no new matter is added.

Information Disclosure Statement

The Office Action states that the Information Disclosure Statement filed April 19, 1999 fails to comply with the provisions of 37 C.F.R. §§ 1.97 and 1.98 and MPEP § 609 because the PTO-1449 form did not contain publication dates of the three cited references. The Office Action states that the references contained in this Information Disclosure Statement were been placed in the file and have not been considered as to the merits.

Applicants submitted an Information Disclosure Statement on April 10, 2000, which included the date of public availability of two references (GenBank Accession Nos. AF06493 and AF071542) originally cited in the April 19, 1999 Information Disclosure Statement. The third reference contained in the Information Disclosure Statement filed April 19, 1999, GenBank Accession No. AF030698, is already of record. Applicants request consideration of the references contained in the Information Disclosure Statement filed April 10, 2000.

B

Rejection Under 35 U.S.C. § 112(1)

Claims 2, 17, and 20 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention.

Applicants respectfully traverse this rejection with respect to claims 2 and 17. Claim 20 has been cancelled, rendering this rejection of claim 20 moot.

The Office Action alleges that the specification does not enable the subject matter of claims 2 and 17 because the specification does not provide guidance as to what nucleotides may be changed without causing a detrimental effect to the protein to be produced. Applicants respectfully submit that claims 2 and 17 do not contain a limitation that the claimed polynucleotides produce a polypeptide. Claims 2 and 17 are directed to isolated polynucleotides comprising a nucleotide sequence that is at least 95% identical to a sequence that encodes SEQ ID NO:2 and the nucleotide sequence of SEQ ID NO:1, respectively. Although many of the polynucleotides encompassed by claims 2 and 17 encode a polypeptide, a polypeptide itself is not claimed in claims 2 and 17.

Applicants submit that the specification enables one of ordinary skill in the art to make the subject matter encompassed by claims 2 and 17. More specifically, as stated in the specification at page 5, lines 3-8, the polynucleotides of the invention: (i) can be made using standard cloning and screening techniques from a cDNA library derived from mRNA in cells of human fibroblast cells, placenta, and tonsils; (ii) can be obtained from natural sources, such as genomic DNA libraries; and (iii) can be synthetically produced using well known techniques.

In addition to enabling one of ordinary skill in the art to make the subject matter of claims 2 and 17, the specification also provides several uses for the claimed

B

polynucleotides. These uses include using the claimed polynucleotides for at least one of: (i) chromosomal localization (see specification at page 9, lines 28-33); (ii) as a hybridization probe to isolate cDNA and genomic clones of other genes (including genes encoding paralogs from human sources and orthologs and paralogs from species other than human) (see specification at page 5, lines 24-29); (iii) as a tool in the recombinant production of SBSEMVLP polypeptides or their variants (see specification at page 5, lines 9-13); and (iv) as a diagnostic reagent (see specification at page 8, lines 14-19). Thus, Applicants submit that the specification enables one of skill in the art to make and use the subject matter of claims 2 and 17. Withdrawal of this rejection is requested.

Claim Amendments

Applicants appreciate the indication in the Office Action that claims 13-15 and 18 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants have amended claim 13 to independent form and have amended claims 14, 15, and 18 to depend from claim 13. No new matter is added by the amendments to claims 13-15 and 18.

Summary

In view of the foregoing amendments and remarks, Applicants submit that this application is in condition for allowance and respectfully request early and favorable notification to that effect. If it would expedite prosecution of this application, the Examiner is invited to confer with Applicants' undersigned attorneys.

Applicants reserve the right to prosecute, in one or more patent applications, the

B



claims as originally filed, the cancelled claims, and all other claims supported by the specification.

Respectfully Submitted,

RATNER & PRESTIA

A handwritten signature in cursive script, appearing to read "R. L. Andersen".

Robert L. Andersen, Reg. No. 25,771

Paul D. Golian, Reg. No. 42,591

Attorneys for Applicants

Dated: April 28, 2000
Suite 301
One Westlakes, Berwyn
P.O. Box 980
Valley Forge, PA 19482-0980
(610) 407-0700

The Assistant Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. **19-2387** of any fees associated with this communication.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on the date indicated below.

April 28, 2000

A handwritten signature in cursive script, appearing to read "Frances Petrillo".

B